

SEP 19 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: THYES ET AL.

SERIAL NO. 09/889,383

FILED: FEBRUARY 05, 2002

FOR: A PROCESS FOR REDUCING THE CONTENT OF ETHYL 3-DIMETHYLAMINO-2-PHENYLPROPIONATE IN SOLUTIONS OF ETHYL 2-DIMETHYLAMINO-1-PHENYL-3-CYCLOHEXENE-1-CARBOXYLATE

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Signature

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CONTINUED EXAMINATIONPRELIMINARY SUBMISSION

Sir:

This is a Request for Continued Examination pursuant to 37 C.F.R. §1.114 which is filed in response to the final Office action of November 16, 2004. For further prosecution, kindly enter and consider the attached preliminary amendments¹⁾ and the following preliminary remarks:

PRELIMINARY REMARKS

Claims 3 to 8 as set forth in Appendix I of this paper are now pending in this case. Claims 1 and 2 have been canceled, and Claims 3 to 8 have been added as indicated in the listing of the claims.

¹⁾ Cf. the Claim Amendments set forth in Appendix I on pages 5 and 6 of this paper.

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Accordingly, applicants have rewritten Claims 1 and 2 as new Claims 3 and 4. New Claim 3 differs from Claim 1 in that it further brings out that the claimed process provides for a selective conversion of the ethyl 3-dimethylamino-2-phenyl-propionate into ethyl atropate by eliminating dimethyl amine without essentially affecting the cis/trans ratio of the ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate. The respective feature of applicants' procedure is, for example, addressed on page 4, indicated lines 28 to 32, of the application. Additionally, Claim 3 differs from Claim 1 in that it further brings out that the starting material of the selective conversion is a solution of the contaminated cis/trans mixture of the ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate in a water immiscible solvent, as addressed on page 3, indicated lines 6 to 13, of the application. New Claims 5 to 8 have been added to further bring out some of the subsidiary embodiments of applicants' process which are addressed on page 3, indicated lines 21 to 27,²⁾ and on page 3, indicated lines 9 and 10,³⁾ of the application. New Claim 8 essentially corresponds to new Claim 4 with the difference that Claim 4 depends upon Claim 3 whereas Claim 8 depends upon Claim 6. No new matter has been added.

In light of the foregoing and the following remarks, the Examiner's rejection of applicants' Claims 1 and 2 as being unpatentable under 35 U.S.C. §103(a) in light of the teaching of GB 1,226,318 is no longer deemed to be applicable.

The teaching of GB 1,226,318 provides for two different procedures, namely

- (1) a procedure in which a cis/trans mixture of the ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate is separated by selectively precipitating a salt of the trans isomer from an alcoholic solution of the mixture by adding to the alcohol solution from 1.0 to 1.2 mol oxalic acid or furmaric acid per mole of the trans isomer;⁴⁾ and
- (2) a procedure in which the cis isomer of ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate is isomerized to form a cis/trans mixture of the ethyl 2-dimethylamino-1-phenyl-3-cyclo-

2) Ie. new Claims 5 and 7.

3) Ie. new Claim 6.

4) Cf. e.g. page 1, indicated line 76, to page 2, indicated line 15, page 2, indicated lines 39 to 116, and page 3, indicated lines 123 to 130, of GB 1,226,318.

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hexene-1-carboxylate by adding from 2 to 6 mol of an organic acid per mole of the cis isomer, optionally in the presence of a solvent.⁵⁾

Applicants' claims in contrast thereto relate to a procedure in which an ethyl 3-dimethylamino-2-phenyl-propionate contaminant of a cis/trans mixture of ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate is selectively converted into ethyl atropate by eliminating dimethyl amine, and the respective conversion is conducted without essentially affecting the cis/trans ratio of the ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate.

Applicants' process differs from the procedures (1) and (2) of GB 1,226,318 on the one hand in the particular result which is achieved in accordance with applicants' invention. Moreover, applicants' process differs from the procedure (1) of GB 1,226,318 at least in the distinctly different requirements regarding the solvent: while the procedure of GB 1,226,318 requires the use of an alcohol it is mandatory in accordance with applicants' process that the cis/trans mixture be provided in a water immiscible solvent. Additionally, applicants' process differs from the procedure (2) of GB 1,226,318 at least in the distinctly lowered amounts of carboxylic acid which are employed.

In order to establish a *prima facie* case of obviousness, three basic criteria have to be met:

- (1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference,
- (2) there must be a reasonable expectation of success, and
- (3) the prior art reference must teach or suggest all of the claim limitations.

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and cannot be based on applicants' disclosure.⁶⁾ Where applicants' invention and the teaching of GB 1,226,318 is concerned at least the criterion (3) is not met because GB 1,226,318 contains nothing which would suggest or imply that it is possible to selec-

5) Cf. page 2, indicated lines 16 to 38, page 2, indicated line 117, to page 3, indicated line 122, and page 3, indicated line 130, to page 4, indicated line 23, of GB 1,226,318.

6) Cf. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991).

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tively convert ethyl 3-dimethylamino-2-phenyl-propionate into ethyl atropate without essentially affecting the cis/trans ratio of the ethyl 2-dimethylamino-1-phenyl-3-cyclohexene-1-carboxylate under the particular conditions which are specified in applicants' claims. It is well settled that not only the materials used and the nature of the specific process employed but also the particular result which is obtained must be considered when determining whether a claimed method is obvious within the meaning of Section 103(a).⁷⁾ In light of the respective guidelines for determining obviousness of a claimed invention which were developed by the Courts, the teaching of GB 1,226,318 can therefore not be deemed to render the subject matter of applicants' claims *prima facie* obvious within the meaning of Section 103(a). Favorable action is respectfully solicited.

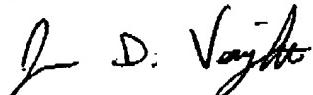
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. The respective \$1020.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Encl.: CLAIM AMENDMENTS (Appendix I)

JDV/BAS

7) In re Dillon, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (CAFC 1990) (*en banc*), cert. denied, 500 U.S. 904 (1991).